

Remarks:

This application has been reviewed carefully in view of the Office Action mailed May 4, 2006 ("the Office Action"). In the Office Action, claims 2, 4, 6-12 and 15 were again rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Miura, U.S. Patent No. 6,322,451, in view of Begis, U.S. Patent No. 6,024,643. Claim 13 was again rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Miura in view of Begis, and further in view of Luciano, Jr., U.S. Patent No. 6,050,895. Newly added claims 16-21 were rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Miura in view of Begis, and further in view of Quake III Arena™ video game manual.

The above-described rejections are addressed as follows:

I. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

A rejection for obviousness is based on the underlying factual inquiries set forth in *Graham v. John Deere*: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of secondary considerations. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve*, 796 F.2d 443, 447 (Fed. Cir. 1986). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In regarding Fritch*, 972 f.2d 1260, 1266 (Fed. Cir. 1992). The appropriate inquiry is not whether it would have been obvious to substitute an element, or modify the prior art, in a manner advanced by the Examiner, because that is not the appropriate test of patentability. *See, e.g., In regarding Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Rather, to meet its burden of showing prima facie obviousness, the PTO must necessarily show some objective teaching that would lead one of ordinary skill to combine the relevant teachings to solve the problem confronting the applicant. *In regarding Fine, supra*.

In sum, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or

combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on an applicant's disclosure. (See, M.P.E.P. § 706.02(j)).

A). The Cited Art Fails to Suggest All the Claim Limitations

Independent claim 7, as amended, recites:

... a device for notifying the actual game players of the availability of the selected virtual game players to competitively play by sending a mail message that preparation for a game is completed after connection between the server and the actual game players is discontinued temporally, the device for notifying being configured such that the virtual game players appear to the actual game players as actual game players. (Amended text emphasized).

Support for this amendment can be found on pages 24-25 of the specification, where this feature is discussed in further detail, as well as in other places throughout the specification. Independent claims 8 and 9 have been similarly amended to add the feature of sending a mail message notification.

In independent claims 7-9, as amended, the server disconnects the connection to the actual player and then later notifies the actual players of the availability of the selected virtual game players to competitively play. Therefore, the server purposely operates as if the virtual players are actual players since the server purposely disconnects the connection, and then sends the mail notification to the actual players, even though the server could have immediately set up a game with the participation by virtual players after only a few moments, without disconnection of the player. The disconnection and subsequent mail notification strengthen the actual player's belief and furthers the illusion that an actual player has now logged in and is ready to play.

Both Miura and Begis fail to disclose the feature of sending a mail message that preparation for a game is completed, the message being sent to actual players who have

been disconnected from the server, such that the virtual game players appear to be actual game players.

5 B). Applicants Respectfully Traverse the Office Action Interpretation of the Cited Art

In the discussion of the rejection of claims 16-21, the Office Action asserts that the following disclosure is provided in Miura:

10 “[A] player can select an opponent and reserve a game space to play against an opponent. If the opponent is playing a match at the time a notification flag is activated indicating the status of the opponent. (Fig. 5). The player is on standby until the opponent is available as which notification will be provided (Col 2:39-54, Col 6:31-43). Thus, this is interpreted as a means for notification that the preparation of the upcoming game is complete. Although not disclosed, inherently,
15 while the player is waiting for an opponent, the server connection is not active until notification occurs.” (Office Action, bottom of page 4, through the top of page 5.)

20 Applicant respectfully traverses the assertion that the server connection is not active after the player in Miura has selected an opponent and/or reserved a game space and is waiting. Moreover, even if the Miura server connection was inherently not active, that does not provide or imply that the connection was discontinued temporally, as is claimed by the applicant.

25 i) The Miura Server Connection is Active

30 Miura discloses that when a game has been reserved, the player is free to offer a challenge to another available player, or to choose to play the computer until the reserved player is available. Miura further discloses a step where, if the player does not choose or reserve another player, the player automatically begins play against the computer opponent.

35 These disclosures can be seen both in the flow chart of Figs. 8A-8B (steps S8 and S9) as well as in the related discussion (Col. 8:25-29): “If the player has not selected to fight against any other player, the procedure sets a fight between the player and the computer and then the fight is started (Steps S9 and S15).” If the player has reserved a

new fight, and the selected player is fighting, "... the procedure sets a fight between the player and the selected player and then initiates the fight (steps S11 and S15)" (Col. 8:34-35). And, "[I]n the Step S13 the player has to wait until the reservation is accepted, but it may be configured that the player may cancel the reservation when he or she does not
5 desire a prolonged waiting time." (Col. 8:43-46). Each of these disclosed scenarios clearly show that the player is still actively and temporally connected to the game server.

Further suggestion that the player is actively and temporally connected may be found in FIGS. 5 & 6, and in the overall flowchart of Fig. 8. Nowhere in Fig. 8 or in the
10 text of Miura is it suggested that a game player disconnects from the network server. Indeed, in Figs. 5 and 6, a small countdown timer (bottom right hand corner of both figures) is actively displayed showing the amount of time remaining before the player will automatically start a game against the computer opponent if another choice isn't made.

Clearly, in Miura the server connection is maintained while the player awaits
15 notification that the reserved player is now available. Indeed, if the player chooses to cancel his reservation for the reserved player due to the wait, this step is also performed while connected to the server. No notification to a player who is not connected to the server system is disclosed in Miura.

Thus, the server connection is clearly active after the player in Miura has selected
20 an opponent and/or reserved a game space and is waiting.

ii) Miura Fails to Disclose a Connection Discontinued Temporally

While applicant does not agree that the Miura connection is inactive (as described
25 above), applicant further notes that an inactive connection is not the same thing as a connection that is temporally discontinued, as is claimed by the applicant. The applicant's specification is clearly directed at situations where a player has disconnected from a
30 system rather than actively waiting. In support of this, the applicant notes the following portions of the specification:

(1) It is seldom that the competitor is always present at the time of connect with the server. Therefore, the fact is that due to the absence of the competitor, the user often gives up receiving the competitive game service and releases the connection with the server. (page 1, line 24 to page 2, line 2)

(2) In the "standby mode" shown in Fig. 17, to the message "No enrollee. Game entry is desired?" on the display part 24 of the portable telephone 13A, when the user selects "Enrollment," the display of the display part 24 is changed to the message that "Enrollment is completed. You are informed by mail when everything is ready." Then, connection is discontinued temporally, so that the user is registered on a competitor list (data base 34). On the other hand, when other user enters the "game room" and designates a standby user on the competitor list, the message that preparation for game is completed is sent with electronic mail service from the server 18 to the portable telephone 13A of the standby user. (page 22, lines 14-23)

C). The Office Action Fails to Establish a Prima Facie Case of Obviousness

For the reasons recited above, the cited prior art fails to teach or suggest the notification feature of independent claims 7-9, and therefore, the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 7-9. Furthermore, the cited art fails to teach or suggest notifying a player having a connection that was discontinued temporally. Claims 2, 4, 6, 10-13 and 15-21 all depend from corresponding claims 7-9, reciting features that further distinguish over the cited references. For these reasons, the rejections of claims 2, 4, 6-13 and 15-21 under 35 U.S.C. § 103(a), are improper, and Applicant respectfully requests they be withdrawn.

II. CONCLUSION

In view of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

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Respectfully submitted,

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